

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JURGEN HERRMANN and WERNER REINHART

Appeal No. 1998-2673
Application 08/557,138¹

ON BRIEF

Before STONER, Chief Administrative Patent Judge, and
FRANKFORT, and BAHR, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

We commence by stating our understanding that the sole issue before us for review is the propriety of the examiner's rejection of claims 19, 21, 30 and 31 under 35 U.S.C. § 103 as

¹Filed November 16, 1995, which is a 35 U.S.C. § 371 filing of PCT Application No. PCT/DE94/01185, filed October 6, 1994.

unpatentable over British patent publication 1,604,463 to Lee² in view of U.S. Patent No. 5,248,544 to Kaule³ (brief⁴, page 3; answer⁵, page 3). For reasons expressed hereinafter, we *reverse*.

Before addressing the § 103 rejection, we feel obliged to note certain anomalies in the manner in which the claims have been handled during the prosecution. Jurgen Herrmann and Werner Reinhart (appellants) noticed their appeal "from the decision dated July 7, 1997 of the Primary Examiner finally rejecting Claims 19 to 37."⁶ Although the identification of claims in the notice was consistent with the summary sheet accompanying the final Office action dated July 7, 1997,⁷ and the summary provided in the advisory action,⁸ each of which

²Published December 9, 1981.

³Issued September 28, 1993.

⁴Paper No. 12, filed February 13, 1998.

⁵Paper No. 13, mailed April 29, 1998.

⁶Paper No. 11, filed December 23, 1998.

⁷Paper No. 6.

⁸Paper No. 10, mailed September 30, 1997.

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indicated that claims "19-37" had been rejected, in truth the examiner had only rejected

claims 19, 21 and 30 through 33. Review of the final Office action shows that claims 19, 21, 30 and 31 were rejected under 35 U.S.C. § 103 and claims 30 through 33 were rejected under 35 U.S.C. § 112, second paragraph. In that final Office action, claims 20, 22 through 29, and 32 through 34 were indicated as being allowable "if rewritten to include all of the limitations of claim 19 and any intervening claims," claims 32 and 33 additionally requiring amendment to overcome the rejection under § 112, second paragraph. No mention of claims 35 through 37 was made in the body of the final Office action, apart from a complaint concerning erroneous claim numbering.

In an effort to cure the rejection under 35 U.S.C. § 112, second paragraph, the appellants presented an amendment which would have made claim 30 depend from claim 19 rather than from canceled claim 1. That amendment was denied entry and no other correction of the dependency of claim 30 has ever been

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entered. Indeed, claim 30, as reproduced in the appendix to the appellants' brief is written as dependent from claim 1 and is accompanied by a footnote indicating that it would depend from claim 19, had a post-final amendment been permitted entry. The appellants address claim 30 in the brief as though it depends

from claim 19 (brief, page 4). Notwithstanding, the examiner has not repeated the rejection of claims 30 through 33 under 35 U.S.C. § 112, second paragraph. Seemingly, the examiner accepts that, should the appellants be successful on this appeal, they will amend claim 30 to depend from claim 19, and has dropped the § 112 rejection accordingly. In light of these comments, we, too, shall treat the rejection under 35 U.S.C. § 112, second paragraph, as having been dropped and treat claim 30 as though it depends from claim 19.

The subject matter of the claims on appeal is directed to a value-bearing document. Despite the appellants' and examiner's indication to the contrary, the copy of claim 19 in the brief is not a correct copy of the claim involved in the

appeal. Independent claim 19 was amended in the amendment filed April 17, 1997,⁹ the communication to which the examiner's final Office action is said to respond. The correct version of independent claim 19 is reproduced below:

A value-bearing document, which comprises:

a carrier member denominated with a value and having a planar surface and a depressed surface, said depressed surface including an opening formed in said carrier member, said planar surface including a security element; and

an at least partially transparent cover foil mounted on said depressed surface and covering said opening.

As we indicated at the outset, the sole issue before us is whether claims 19, 21, 30 and 31 are properly rejected under 35 U.S.C. § 103(a) as unpatentable over Lee in view of Kaule. After a review of the record as a whole, we are in agreement with appellants that the examiner has not made out a *prima facie* case of obviousness. Accordingly, we are constrained to *reverse*.

The value-bearing document of claim 19 requires a carrier member having a planar surface and a depressed surface, with

⁹ Paper No. 5.

the depressed surface including an opening formed in the carrier member. Claim 19 also requires "an at least partially- transparent cover foil mounted on said depressed surface and covering said opening." According to the examiner, Lee teaches a document that meets these claimed limitations (final Office action, page 3). Other than providing a cryptic note in the advisory action that "British document 1604463 [Lee] teaches a depressed surface with a foil component at Fig. 4", the examiner makes no specific reference to any portion of Lee being relied upon to support this position.

Our review of Lee (giving particular attention to Figure 4) reveals that Lee's document comprises a carrier member 1 with a marking element 4 in the form of a wavy strip 5 (security element) embedded within it (Lee, page 1, lines 73-85; page 3, lines 55-77). This marking element 4 only becomes visible when apertures (e.g., 7 in Figure 4) are made (as by controlled cutting, abrading or burning) in the surface of the

carrier member (Lee, page 2, lines 51-59). It is difficult to know precisely what the examiner would have us understand in Lee to define the depressed surface set forth in claim 19 on appeal. Perhaps the examiner considers the surface of strip 5 seen in Figure 4 of Lee to be the depressed surface.

Alternatively, perhaps the examiner considers the surface of a particular aperture 7 itself to be the depressed surface.

Irrespective of which of these the examiner would have us consider to correspond to the depressed surface claimed by appellants, we find no disclosure in Lee of a depressed surface which "include[es] an opening formed in said carrier member" as recited in claim 19. In our view, the only openings that exist in the carrier member of Lee are the recessed apertures 7 and these apertures are each

formed in only one or the other of the planar surfaces of the document. None of the apertures 7 are located in any depressed surface that may be formed as a result of the aperture formation process. We find ourselves in agreement

with the appellants' arguments that:

- (1) the "difference between the British reference [Lee] and Appellant's [sic] novel contribution is quite clear. In accordance with Appellant's [sic] novel contribution, the carrier member of the value-bearing document once prepared is thereafter formed with a depressed surface and with an opening in such depressed surface whereupon a cover foil is mounted OVER the opening ON the depressed surface" (appeal brief, page 9); and
- (2) in Lee, "there is no opening within a depressed surface over which a cover foil is mounted to cover the opening, but as illustrated in Figure 4 and described in the specification, the thin thread element 5 is a part of the sheet instead of being a cover foil subsequently covering the opening and mounted on a depressed surface" (appeal brief, page 10).

Since the secondary reference to Kaule, upon which the examiner exclusively relies for a teaching of a security element carried upon a planar surface of a value bearing document, does not overcome the identified deficiencies of Lee, we conclude that

the examiner has not met his burden of setting forth a *prima facie* case of obviousness. Accordingly, the decision of the

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examiner is *reversed*.

REVERSED

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| BRUCE H. STONER, JR., Chief |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| CHARLES E. FRANKFORT |) | APPEALS AND |
| Administrative Patent Judge |) | INTERFERENCES |
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| JENNIFER BAHR |) | |
| Administrative Patent Judge |) | |

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Charles R. Hoffmann, Esq.
Hoffmann & Baron , LLP
6900 Jericho Turnpike
Syosset, NY 11791